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In re Application of	:	DECISION ON
Malcolm Lovell HANDEL et al	:	
Application No.: 10/068,471	:	
Filing Date: 04 February 2002	:	PETITION
Attorney's Docket No.: 273402003300	:	
For: TREATMENT OF INFLAMMATORY	:	
AND MALIGNANT DISEASES	:	UNDER 37 CFR 1.182

This is response to applicants' "PETITION TO CONVERT A 35 USC 111 TO APPLICATION TO §371 APPLICATION" filed 18 April 2003 requesting to convert the above captioned- application to a national phase application filed under 35 U.S.C. 371. The appropriate petition fee of \$130.00 has been paid by check.

### **BACKGROUND**

On 04 August 2000, applicants filed international application PCT/AU00/00932, which claimed priority of an earlier application filed 04 August 1999. A copy of the intentional application was transmitted on 15 February 2001 to the USPTO from the International Bureau.

A Demand electing the United States was filed in this international application on 19 February 2001. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 04 February 2002.

On 04 February 2002, applicants filed a transmittal letter for the filing of a utility application, which was accompanied by, *inter alia*, a specification, and claims.

On 02 April 2002, the USPTO mailed applicants a "NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION FILED UNDER 37 CR 1.53(b)." The notice indicated, *inter alia*, that the the statutory basic filing fee is missing and that applicant must submit \$740 to complete the basic filing fee for a non-small entity.

On 29 October 2002, applicants filed, *inter alia*, a "FEE TRANSMITTAL FOR FY 2002." Applicants included the utility filing fee of \$720.00 to satisfy the notice and to comply with filing the application under 37 CFR 1.53(b). Accordingly, the application was properly processed as a filing under 35 U.S.C. §111(a).

On 18 April 2003, petitioner filed the instant petition to convert the above application filed under 35 USC §111(a) to a national stage application filed under 35 USC §371. In addition, petitioner filed a Transmittal Letter under 37 U.S.C. 371.

### DISCUSSION

Any intended filing under 35 U.S.C. 371 (a national stage application) must clearly and unambiguously be identified as such, otherwise the submission will be treated as being filed under 35 U.S.C. 111(a). Note 37 CFR 1.495(g) and MPEP 1893.03(a). Petitioner indicates on page 2, second paragraph shows intention to file under 35 U.S.C. 371 because it was stated that the "...application data sheet containing no continuity information, but designating as prior foreign applications...", however this is not persuasive for the below reasons.

Applicants' submission, including the Utility Patent Application Transmittal letter under 37 CFR 1.53(b) on 18 April 2003, did not request treatment under 35 U.S.C. 371. Moreover, applicants did not pay the full national basic fee, and applicants did not indicate that they wished to pay the basic national filing fee. Instead, applicants subsequently on 29 October 2002 paid the filing fee of \$740.00 for a filing under 35 U.S.C. 111(a), therefore the application was properly treated under 35 U.S.C. 111 (a) (37 CFR 1.495(g)).

United States statutes and regulations do not make specific provisions for the requested action and as such the Office does not grant such petitions for conversion as a mere matter of course. The Office will only grant such petitions upon a showing by applicant of sufficient cause (e.g., the loss of patent rights) where no other remedy is available.

In the present petition applicants have not made a showing that any loss of grant rights would occur if the above-captioned application remains a filing under 35 U.S.C. 111(a). Accordingly, applicants have not established sufficient cause for conversion from a 35 U.S.C. 111(a) application to an application filed under 35 U.S.C. 371.

Applicants, however, are entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, because this application (Serial No. 10/068,471) and the international application (PCT/AU00/00932) designating the United States were copending on 21 July 2004. However, applicants must comply with the provisions of 37 CFR 1.78 to correct the claim priority to the international application

Applicants are reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit a certified copy of the priority document. The certified copy of priority document submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

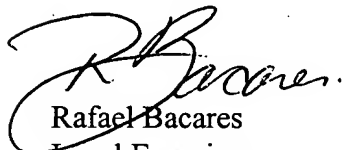
In the alternative, applicants could file a separate national stage application (accompanied by a petition for revival of the international application) and thereby initiate the desired national stage application.

### **CONCLUSION**

For the reasons noted above the petition under 37 CFR 1.182 is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition is desired, applicant must file a request for reconsideration within a **TWO (2) MONTH** non-extendable time period from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Second Renewed Petition."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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